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**DIRECTOR'S OFFICE  
TECHNOLOGY CENTER 3600**

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Paper Number 12

In re application of	:	
Edward J. Petrus	:	
Application No. 09/444,660	:	DECISION ON
Filed: November 22, 1999	:	PETITION REGARDING
For: METHOD/PROCESS OF DETERMINING	:	REQUEST TO
A PERSONAL DIETARY SUPPLEMENT	:	WITHDRAW
PROFILE AND RECOMMENDING DIETARY	:	FINALITY UNDER
SUPPLEMENTS FOR AN INDIVIDUAL	:	37 CFR 1.181

This is a decision on the PETITION under 37 CFR 1.181, apparently filed on DECEMBER 9, 2002, and re-submitted FEBRUARY 21, 2003, requesting withdrawal of the finality of the Office Action mailed SEPTEMBER 11, 2002, as being premature.

The petition is **DENIED**.

## DECISION

Applicant alleges that the Final Rejection mailed September 11, 2002 is premature because the claims were rejected under 35 U.S.C. §102 as being anticipated by Summerell in a previous Office Action mailed March 15, 2002, and then finally rejected under a new ground of rejection, namely under 35 U.S.C. §103 as obvious in view of Summerell and Riley.

MPEP §706.07(a) sets forth that second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

A review of the record shows that in response to the rejection of the claims under 35 U.S.C. § 102 as being anticipated by Summerell in the Office Action mailed March 15, 2002 (paper number 3), Applicant amended the claims, *inter alia*, to include a step of "adjusting for differences in the individual's health information when compared to an optimal health profile" within independent claim 1. This feature is a significant change in the scope of the invention claimed, as this feature was never present in any of the originally filed claims 1-10, nor is it a feature that should reasonably have been expected by the Examiner to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. § 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element. Rather, it appears that Applicant introduced the aforementioned feature into the claims for the first time in the amendments of June 11, 2002 and June 24, 2002 as a point of distinction over the Summerell reference.

In view of the fact that the Final Rejection mailed September 11, 2002 was based on a new grounds of rejection, namely under 35 U.S.C. § 103 as obvious in view of Summerell and Riley, that was clearly necessitated by Applicant's amendment to the pending claims, it is not seen that finality of the September 11, 2002 Office Action was improper.

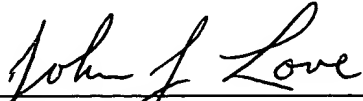
In addition, Applicant asserts that the Examiner's statement that "Applicant's arguments filed 6/24/02 have been fully considered but they are not persuasive" in the Office Action mailed September 11, 2002 precludes the Examiner from introducing a new grounds of rejection. This is incorrect. MPEP § 706.07(a) clearly sets forth that it is the amendment to the claims, and not Applicant's arguments, *per se*, that are the basis for determining whether new grounds of rejection are necessitated. In this case, as noted above, the addition of the step of "adjusting for differences in the individual's health information when compared to an optimal health profile" within independent claim 1 was sufficient to necessitate the new grounds of rejection.

Applicant asserts that "no clear issue had been communicated to the Applicant from the Examiner" prior to Final Rejection mailed September 11, 2002. This is incorrect. The Office Action mailed March 15, 2002 was at least 14 pages in length and provided specific reasons for objections to the specification and to the claims, as well as detailed rejections under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph and 35 U.S.C. § 102. In fact, Applicant's responses filed June 11, 2002 and June 24, 2002 do not indicate a lack of clarity in the Examiner's objections and rejections, nor a lack of basis for the Examiner's stated positions. Furthermore, in another communication prior to the final rejection mailed September 11, 2002, the telephonic interview of June 2, 2002, Applicant never indicated that there was a lack of clear issues in the case. Rather, Applicant appeared to rely on features of the invention which were never present in the claims until the amendments filed June 11 & 24, 2002. As such, Applicant's assertions are not persuasive.

The remainder of the petition is directed to the merits of the prior art rejections and appears to be relevant to an appeal, but is immaterial to the issue of whether the Final Rejection of September 11, 2002 is premature. As such, Applicant's remarks in the section entitled "2. A rejection under § 103 for obviousness is without merit" at pages 3-8 and attached court

citations are better suited for an appeal of the merits of the rejections rather than a decision on the petition to withdraw the finality of a rejection.

For the foregoing reasons, the finality of the Office Action mailed September 11, 2002 is proper and no abuse of discretion or arbitrary or capricious action is evidenced.

A handwritten signature in cursive script, reading "John J. Love". The signature is written in dark ink and is positioned above a horizontal line.

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